



enterprise europe

Guidelines on IPR Issues

in EEN practice



Business Support on Your Doorstep



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Introduction and Scope

1.1. About the Enterprise Europe Network

The Enterprise Europe Network is a European initiative aimed at providing innovation and business support to organisations, in particular small- and medium-sized enterprises (SMEs), across the EU and beyond.

Since January 2008, the Network comprises close to 600 partners in over 50 countries (EU and non-EU) offering a wide range of services, including access to partners (the world's largest international business and technology transfer network), information (providing answers on the practicalities of doing business internationally), finance (providing advice and guidance on sources of EU funding) and developing research and innovation capacities.

1.2. What these Guidelines are for

A key aspect of EEN services is to help EEN clients to trade and exploit their Intellectual Assets (IA) on an international level. These guidelines aim to:

- (i) help you understand key issues on such intangible assets, including (IA) and a subset of these intangibles, intellectual property rights (IPR); and
- (ii) why you as an EEN adviser should be aware of such intangibles when working with clients.

This is particularly important when issuing profiles or other material on behalf of EEN clients in any publication (e.g. Technology, Research or Commercial profiles for EEN databases, websites etc.), advising/signposting EEN clients on IP issues during partner negotiation, brokerage events and/or in future collaborative research projects (e.g. Horizon 2020).

EEN advisers should also be made aware of IP training and assistance available from internal and external sources for their own use in internal EEN training and also for delivering general EEN IP awareness raising events, as per contractual requirements etc.

More in-depth EEN IPR advice will be crucial in coming years not only to raise the quality of the Network, but will be central to many EEN services.

1.3. Sources of Help on IP/IA for EEN advisers

IPR and IA can be complex areas and should be dealt with on a case by case basis, working with internal EEN or external IP experts and stakeholders, where appropriate/available.

Guidance and advice should also be sought and shared between EEN advisers on IP issues, where appropriate (e.g. for assistance on further support/contacts/expertise on a national level etc.). The spreadsheet "*EEN IP signposting directory on IP support services*" comprises a list of national and regional EEN advisers with a focus/background on IP issues.

For additional support, EEN advisers should consider seeking additional IP training as part of their continued development. Please see centralised/decentralised EEN training events with a focus on IP/IA on the Intranet training pages.

Non-EEN training, information and tools are also available from a number of external parties. Although not exhaustive, a selection of key providers of IP/IA assistance and tools may be found in various documents created by the EEN IP WG II, 2013 including:

- **Task I – "Recommended methods for cooperation between EEN and major IP stakeholders"**
- **Task II – "IP tools – flow chart, including EEN adviser and customer journey"**
- **Task IV – spreadsheet "EEN IP signposting directory on IP support services"**
- **Task V – "IP/IA Case studies"**

1.4. How can IP advice help EEN clients?

- **Often you may find that SMEs are quoted as stating that IPR/IA is**

"difficult to obtain"... "only relevant to high tech companies or multinationals" and "costly to protect". They may therefore look to exploit their innovations using approaches such as maintaining lead-time advantages, developing high-trust relationships or other informal methods before considering protecting their innovations using formal IPR registration systems (patents/



trade marks/designs/utility models). Whilst this may be an appropriate strategy to adopt, EEN advisers should ensure:

- their clients have the appropriate knowledge and tools to consider how best to manage their IA/IP and lever maximum commercial benefit from any IPR/IA that has been created
- they offer at least basic advice on IA/IP to ensure their clients understand the scale and nature of their IA (eg by way of an IA/IP diagnostic as part of drafting a Technology/Commercial/Research EEN profile)
- their clients are aware of the added value that appropriate management of IA can bring to their business.
- it is just as important for service-based companies as technology companies
- they help to raise awareness of the value of IPR as a business tool in business co-operation, partnership and commercialisation and how the EEN can help further
- clients are signposted to appropriate further/professional IP advice where necessary.

For more information, see spreadsheet "EEN IP signposting directory on IP support services"

or consult the EU-wide links below
https://www.iprhelpdesk.eu/SME_Corner
<http://www.innovaccess.eu/index.php>

1.5. EEN Deliverables and PES Outcomes

It is assumed that most EEN consortia will deliver an element of IP activity as part of a particular Work Package of their EEN delivery contract. For example:

1.5.1. Activity 6

Provision of Internationalisation and Innovation Support. It is therefore important to understand IPR activity in daily EEN practice in order to capture such activity.

1.5.2. PES Item 28

PES Data Item Nº 28 has the requirement to capture outcomes of advisory services including as follows: *Outcomes of advisory services provided under data items 8. For example, this may comprise... adv/ce provided on IPR issues resulting in a IPR audit/action plan, patent/registered design/registered trade mark applied for; capturing and managing client IA (e.g. customer lists, contracts, including employee contracts, know how, show how, market knowledge, accreditations etc.).*

1.5.3. Success stories

A success story is a documented action that followed a specific request from a company and had a positive impact (financial or other, such as intensive IPR support as set out above for PES28) on the client's activities. A success story should

- result from an eligible activity of a Network partner responsible for the region where the client is located;
- clearly describe how the Network partner has helped a company;
- clearly demonstrate a positive impact (financial or other) for the client;
- feature recent work and current EU programmes;
- feature companies that have agreed to publication.

There are two types of success stories

1. Stories published by the EASME (Executive Agency for Small and Medium-sized Enterprises) Communication team that partners need to submit for consideration a) by filling in the success story application form or b) by filling in the success story fields of the Partnership Agreement Report form.
2. Stories published by the partners in their local market that do not need to be submitted to EASME.

Both types of stories can be reported in the PES. Regarding Type 2 above, it is proposed that EEN members share success stories involving IP issues – in order to

- a) raise awareness of IP advice/share best practice for internal EEN purposes;
- b) promote scope of EEN service externally.

Please see **IP section on Intranet**, the **Merlin IP forum** and **LinkedIn Community of Practice "EEN – IPR Group"** (EASME moderated) etc. for more information and sharing of best practice/success stories.

1.6. EEN profiles

1.6.1. Before you start writing

"Time spent on reconnaissance is never wasted". This military saying can also be applied to writing EEN profiles. To prepare good-quality profiles you will find it useful to visit your client to discover the background to a potential new profile (technology, commercial and/or research) and to assess the level of the client's commitment.

However, it is also important for you and your client to understand their IPR/IA BEFORE issuing a profile onto a public database and/or entering into potential collaborative discussions with a third party. For example, the subject of a profile may not have been disclosed or placed on the market before and therefore should be deemed confidential.

See

www.ipo.gov.uk/news/newsletters/ipinsight/ipinsight-201208/ipinsight-201208-4.htm

Questions you might ask to your client are

- Is the timing right to issue a profile?
 - > If yes, how much information may be disclosed in an EEN publication?
- Has your product/process/service/technology etc. been disclosed before?
 - > If no – have you considered protecting your product/service/technology etc. by way of registered IP right BEFORE disclosing?
 - > If yes – Have you filed for a registered right to protect your intangible assets (e.g. Patent/Trade mark/Registered Design)? If so, what?

Important reminder

Once entered onto the Enterprise Europe Network database, EEN profiles are generally sent to all Network Partners, or a geographical sub-set if desired. Ultimately, they will be in the public domain and searchable on the internet etc. Confidential client information should not be disclosed without permission. Any publication may invalidate a claim to a future registered IP right.

1.6.2. IP diagnostic/IP checklist – EEN profile generation

POD Profiles (BO, BR, TO, TR, RDR)

There is a basic "IPR status" section to be completed for all partnership profiles (BO, BR, TO, TR, RPR), but this field is mandatory only for TO, TR, RDR.

Following the POD profile Guidelines it is recommended to *indicate if applicable, the current status of the intellectual property rights of the technology/product. It is possible to select more than one IPR Status as required. Please note that even if this section is not mandatory for BO, BR it is advisable that all selections should be documented in the Comments regarding IPR Status section below.*

- Copyright
- Design rights
- Exclusive rights
- Granted patent or patent application essential
- Others (registered design, plant variety right, etc)
- Patent(s) applied for but not yet granted
- Patent(s) granted
- Secret know-how
- Trade marks

> Comments regarding the IPR Status

This field is not mandatory for BOs, BRs. If applicable, describe clearly all additional information about the IPR status. It is of particular importance to define all countries where any patents have been applied for and granted when the Patent(s) applied for and Patent(s) granted IPR fields have been selected. Additionally, include all information relating to patents that have been granted that are undergoing extension in other countries.

When the IPR Status 'Exclusive rights' has been selected you should indicate in which states where the right or patent was granted and a short outline about the holder of the rights. If 'Others' box was selected you should indicate what exactly the IPR consists of, whether it is plant variety right, design patent etc. or whether no IPR of any kind exists.

Always be aware that if too much 'client sensitive' information is included in this field, you run the risk of leaving the client open to Intellectual Property theft and, as such, maybe subject to potential legal ramifications. Therefore, it is highly important you document this field while balancing the fine line between providing information that is valuable to potential partners without disseminating valuable client information regarding technologies that may be still going through the patent process / development process.



Checklist

Patent(s) applied for but not yet granted

- Is patent application filed? If so:
- Where? Check territories (e.g. National IPO provisional application; PCT/ International; National/Regional Phase etc.)
- Is it self-filed? (warning; if so, potential narrow scope of protection, if any; refer to professional.)
- What is Applicant Name (may be different to inventor if patent rights assigned etc.)
- Is patent published? (If not, is it suitable to publish on EEN database? NB Any EEN publication MAY invalidate client right to future registered IP right)
- At what stage is the patent? Application filed, search report obtained, patent claims examined, patent granted? [Each of these stages has a clear impact on the value of your IP and will influence negotiations to reach a partnership agreement.]

In general, consult the local PatLib or esp@cenet/Patentscope to check status of above etc.

Patents granted

- If granted, have you checked patent in force? (check "Esp@cenet" or "Patentscope" etc for status; or check with local PatLib if available).

Copyright*

Check that your EEN client has a date of creation of copyright and that work is fixed eg written down/recorded etc. (see <http://www.ipo.gov.uk/types/copy.htm>); easier to prove ownership by keeping workings relating to any copyright material created, with evidence of dates, as well as originals.

* NB Copyright is an **unregistered** right, and technically **no registration** process is required. However, some national laws cater for this and it may be useful to lodge the copyright at a registered body e.g. In US, official register of copyright works <http://www.copyright.gov/>

Exclusive rights

- Are you the IP owner/ licensee/assignee? If you obtained IP rights from third party have you registered change of ownership at relevant NIPO?

Secret know-how

- If you are reliant on unregistered rights and IA such as know-how, have you taken action to ensure confidentiality clauses, etc. exist e.g. in employment and contracts with sub-contractors, etc.

Others (Registered Design, plant variety right, etc)

- Registered Design – for further details (e.g. Application/ Design Numbers; Countries of protection etc.) see <http://www.ipo.gov.uk/types/design/d-about/d-whatism.htm>
 - > Is Registered Design in force? (Search here for status of UK Reg Design <http://www.ipo.gov.uk/types/design/d-os/d-find.htm> or for a Community Registered Design visit here <http://oami.europa.eu/ows/rw/pages/QPLUS/databases/searchRCD.en.do>)
- Unregistered Design Right – Further details: eg. See <http://www.ipo.gov.uk/types/design/d-about/d-desianria.htm>
- Utility Patent (not available in all countries; See http://www.wipo.int/sme/en/ip_business/utility_models/utility_models.htm)
- Database right/plant variety rights etc. See <http://www.ipo.gov.uk/types/otherprotect.htm>

GENERAL – Search for technology partners/competitors using patent databases such as the free of charge tools **espacenet** or **patentscope** (<http://www.espacenet.com/index.en.htm>; <http://www.wipo.int/pctdb/en> respectively). Searching may also be conducted via your local PatLib (<http://www.epo.org/searching/patlib/directory.html>).

To help drafting profiles ask for access to client promotion materials (brochure Website...) and if possible patent applications etc.

1.6.3. Organisation/company submitting a profile

POD Profiles: type and size of client

Select the type and size of the organisation who are making the Business Offer

- Industry SME <= 10 (Small to Medium sized enterprise – 10 or less employees)
- Industry SME 11-49 (Small to Medium sized enterprise – 11 to 49 employees)
- Industry SME 50 – 249 (Small to Medium sized enterprise – 50 to 249 employees)
- Industry 250-499 (Enterprise with 250 – 499 employees)
- Industry >500 (Enterprise with more than 500 employees)
- Industry MNE >500 (Multinational enterprise with more than 500 employees)
- Inventor
- Other
- R&D institution (Research and Development institute)
- University (Accredited place of learning)

Use Organisation/Company Type Field to check the ownership of profile to be published.

Always verify that your client has the right to publish (eg they may only have exclusive rights to exploit an innovation in a small geographical region and not all EEN database territory).



1.7. Brokerage Events/Trade Fairs

See EU IPR Helpdesk Fact Sheet "IP issues in brokerage events" <https://www.iprhelpdesk.eu/node/780>

1.8. Negotiations*

For additional information on negotiations, see **How to deal with IP-related issues in transnational negotiation** at <https://www.iprhelpdesk.eu/node/1161>

1.8.1. Documenting/protecting IP prior to negotiations

Before your client proceeds with any negotiations you should ensure that they are aware of their IP/IA and taken steps to appropriately protect their IP/IA. At the most basic level this means creating a detailed record with witnessed notes, documenting the development of the concept or invention (see page 7 notes on copyright). Also important is identifying background IP and ring fencing this before entering into any collaborative research project eg FP7/Horizon 2020 etc. (see <https://www.iprhelpdesk.eu/node/1567>).

1.8.2. Use a non-disclosure/confidentiality agreement

This should assist with more open discussions of confidential information and knowledge.

For more information on such agreements, please visit the IPR Helpdesk website at <https://www.iprhelpdesk.eu/node/969>

1.8.3. Control the amount of disclosure

Despite protection and the use of nondisclosure agreements, you may still want to consciously control the amount of information you disclose to the other party. Only share the information required to encourage engagement with the third party. Don't give away too much until you are comfortable that a trusting relationship has been developed and a deal/collaboration is appropriate for both parties.

1.8.4. Keep complete notes and detailed chronology of discussions

During the negotiations, keep a clear record of all the disclosures made, when and to whom. This will help you with controlling disclosures.

1.8.5. Use of terms sheets

The use of term sheets, also known as "heads of terms/agreement", may help your client with the negotiation process. A term sheet is a list of key terms with a tentative statement on your client's position written under each key term. It clarifies issues, clears positions, and ensures consistency on their position.

It can also work as a valuable guide for the negotiation, allowing the parties to work through each term one by one. See <http://www.ipo.gov.uk/licensingbooklet.pdf>

1.8.6. Agreement and contract

Make sure that agreement is reached on each key term. A lack of clarity on key terms may lead to conflict in the future. Any agreement should be signed by all parties involved. It is a common error to think that a negotiated written document is enforceable and sufficient to commence with the work without it being signed by everyone.

1.8.7. Model agreement templates

Standard agreement templates are available to help with negotiations, however professional legal advice is encouraged. See <http://www.ipo.gov.uk/skeletonlicence.pdf> for sample agreement. Sample model agreements such as the UK "Lambert Agreements", a set of nine model research collaboration agreements for academia-industry collaboration, including guiding notes and decision guide may also be found here <https://www.gov.uk/government/publications/lambert-toolkit-model-research-collaboration-agreements>

Also see "Doing Business" section https://www.iprhelpdesk.eu/SME_Corner

* The Section 1.8 has been adapted from K2i Little Yellow Handbook - FP7 project. <http://www.knowledae2innovation.eu/>





1.9. IP profiling and valuation

Whatever your clients' business, the chances are that their IP and IA will be the most valuable thing that they own. Yet, often these are discounted by businesses and given no value. Whilst identifying and demonstrating value is sometimes seen as a 'black art', the process of evaluating and protecting original ideas (and making them work harder) is a critical aspect for your clients' business.

EEN advisers should provide a route to helping businesses to understand and profile their IP and IA. Ultimately it is these assets that the client will be trading with on an international level using EEN services. This can be done as part of day-to-day EEN services as set out above, for example.

Such IP/IA is often not seen on company balance sheets but this should be encouraged in order to maximize gain from proper management of such. Indeed, it is becoming more common in accountancy practice to incorporate IP/IA on balance sheets (see Capturing IA/IP on Balance Sheets in Annex I). Additionally, EU governments have various tax credit schemes for R&D or IP-based profits, so it is important for a business to understand other means of extracting the most value from their IP/IA. Leveraging these intangible assets is an essential route to helping our innovative client base to grow.

Valuation of IP/IA is a complex area and in simple terms is split into 3 areas: cost, market and income-based methods. Valuations may be conducted by professionals, such as accountants with specialist knowledge of IP valuation. However, the nature of such valuations (especially for pharmaceuticals etc. which have long R&D requirements before hitting the market) can be extremely costly and therefore not so appropriate for our EEN SME client base. There are other more cost effective online IP/IA valuation tools, which may often be accessed via other professional bodies such as patent and trade mark attorneys.

For background see

<http://theintangibleblog.wordpress.com/>

For example, IP/IA profiling and valuation may be important in

- seeking to attract investment (eg financial institutions and investors seek well managed IP rights portfolio)
- collaboration (help you to reach a fair agreement when negotiating with partners when trading IA/IP e.g. license, assignment, mortgage)
- informing business strategy (may suggest and control diversification)
- adding kudos/acting as a marketing tool (think of Dyson, L'Oreal brands etc.)
- sources of future economic benefits
- saving money (possible tax credits for innovations; also, if you are spending money on IA that has no little/value consider investing less time/money in them)
- contribute to individual SMEs' uniqueness
- provide sources of competitive advantage
- agreeing the right price for sale (this may be difficult unless you know the value of your IA/IP, which may not be listed on your balance sheet)





Annex I

1.10. IA/IP – Definitions

(Adapted from BBS Guidelines [WG Quality and Performance/ WG IPR])

Important definitions are provided below as a guide only. For further information on IPR, go to: <http://www.innovaccess.eu/about-intellectual-property.php?section=How> with links to relevant national and regional IPOs etc.

1.10.1. IPR

There are four* main types of Intellectual Property Rights (IPR) specifically recognised as such in law and which are a subset of a broader "intellectual asset" family IPR include:

Patents (and Utility Models)**	Trade Marks (registered and unregistered)
Designs (registered and unregistered)	Copyright

* Other rights protected by statute in various jurisdictions, include semiconductor topography rights, plant breeders' rights, and database rights.

** Utility models aren't available in all territories see www.innovaccess.eu

1.10.2. IA

Other Intellectual Assets may not attract the same legal rights as IPR but can be equally as important for a business/research centre/university etc. These include:

'Know-how'/ 'Show-how'	Market Knowledge	Trade Secrets
Processes	Formulae and algorithms	Contracts
Accreditations (e.g. awards; regulatory accreditations etc.)	Domain Names	Customer supplier knowledge and networks

1.10.3. Copyright

Copyright is the set of exclusive rights granted to the author or creator of an original work. including the right to copy, distribute and adapt the work. These rights can be licensed.

transferred and/or assigned. Copyright lasts for a certain time period (see below) after which the work is said to enter the public domain. Copyright, although an unregistered right, is a right governed by statute and is described under the umbrella term intellectual property along with registered rights – patents, registered designs and registered trademarks.

Copyright can apply to literary and artistic works such as novels poems and plays films videos musical works drawings paintings photographs and sculptures computer software databases and architectural designs etc.

Copyright Term Summary

- Literary dramatic musical or artistic works: 70 years after the death of the author or principal creator.
- Films: 70 years after the death of the last survivor of the principal director, the authors and the composer of any music created for the film.
- Sound recordings: generally protected for 50 years from the year of publication.
- Broadcasts: 50 years.
- Published editions: 25 years.

1.10.4. Patents

A patent is an exclusive right granted for an invention, which is often a product or a process that provides, in general, a new way of doing something, or offers a new technical solution to a problem. In order to be patentable, the invention must fulfil certain conditions (please see the answer to the question below "which kinds of inventions can be patented?").

A patent provides protection for the invention to the owner of the patent. The protection is granted for a limited period, generally 20 years if the annual renewal fee is paid. Patents are territorial, and typically you would commence with a patent application in your own country.

Patent protection means that the invention cannot be commercially made, offered, used, distributed, imported or sold in a country where a patent is granted without the patent owner's consent. These patent rights are usually enforced in a court, which, in most systems, holds the authority to stop patent infringement. Conversely, a court can also declare a patent invalid upon a successful challenge by a third party.

A patent owner has the right to decide who may – or may not – use the patented invention for the period in which the invention is protected. The patent owner may give permission





to, or license, other parties to use the invention on mutually agreed terms. The owner may also sell the right to the invention to someone else, who will then become the new owner of the patent. Once a patent expires, the protection ends, and an invention enters the public domain, that is, the owner no longer holds exclusive rights to the invention, which becomes available to commercial exploitation by others.

Patents provide incentives to individuals by offering them recognition for their creativity and material reward for their marketable inventions. These incentives encourage innovation, which assures that the quality of human life is continuously enhanced.

The first step in securing a patent is the filing of a patent application. The patent application generally contains the title of the invention, as well as an indication of its technical field; it must include the background and a description of the invention, in clear language and enough detail that an individual with an average understanding of the field could use or reproduce the invention. Such descriptions are usually accompanied by visual materials such as drawings, plans, or diagrams to better describe the invention. The application also, for the purpose of examination, contains various "claims", that is, information which determines the extent of protection granted by the patent.

An invention must, in general, fulfil the following conditions to be protected by a patent. It must be capable of industrial application; it must show an element of novelty, that is, some new characteristic which is not known in the body of existing knowledge in its technical field. This body of existing knowledge is called "prior art". The invention must show an inventive step which could not be deduced by a person with average knowledge of the technical field. Finally, its subject matter must be accepted as "patentable" under law. In many countries, scientific theories, mathematical methods, plant or animal varieties, discoveries of natural substances, the presentation of information, or many computer programmes, methods for medical treatment (as opposed to medical products), or inventions that contravene public policy or morality are generally not patentable. The general exception to such patent exceptions is under US law, where often you can "patent anything under the sun that is made by man".

A patent is granted by a National Intellectual Property Office (NIPO) or Patent Office or by a regional office that does the work for a number of countries, such as the European Patent Office (EPO – see <http://www.epo.org>) and the African Regional Intellectual Property Organization (ARIPO – see <http://www.aripo.org>). Under such regional systems, an applicant requests protection for the invention in one or more countries, and each country decides as to whether to offer patent protection within its borders. The WIPO-administered Patent Cooperation Treaty (PCT) provides for the

filing of a single international patent application which has the same effect as national applications filed in the designated countries. An applicant seeking protection may file one application and request protection in as many signatory states as needed. These are useful routes to both planting the flag for potential patent protection in many countries and delaying patent prosecution costs compared with filing national patent applications.

It is important to file a patent application before publicly disclosing the details of the invention. In general, any invention which is made public before an application is filed would be considered prior art and therefore invalidate a claim to any future patent (although the definition of the term "prior art" is not unified at the international level, in many countries, it consists of any information which has been made available to the public anywhere in the world by written or oral disclosure). Some countries, however, allow for a grace period, which provides a safeguard for applicants who disclosed their inventions before filing a patent application, and the novelty criteria may be interpreted differently depending on the applicable law.

If it is inevitable to disclose your invention to, for example, a potential investor or a business partner, before filing a patent application, such a disclosure should be accompanied by a confidentiality agreement.

Further information

<http://www.wipo.int/patentscope/en/patents/>

1.10.5. Utility models

In some countries, inventions may also be protected by **utility models**, which are also known as "petty patents" or "utility innovations." The conditions for the registration of utility models are usually less stringent (since no inventive step or only a less significant inventive step is required), the procedure for registration is faster (since novelty and inventive step are usually not examined prior to registration) and acquisition and maintenance fees are generally lower than those applicable to patents. Applications are usually to be filed with the national IP Office.

Further information

http://www.wipo.int/sme/en/ip_business/utility_models/utility_models.htm

1.10.6. Trade marks

A trademark is a distinctive sign which identifies certain goods or services as those produced or provided by a specific person or enterprise. Its origin dates back to ancient times, when craftsmen reproduced their signatures, or "marks" on



their artistic or utilitarian products. Over the years these marks evolved into today's system of trademark registration and protection. The system helps consumers identify and purchase a product or service because its nature and quality, indicated by its unique trademark, meets their needs.

Trademarks can be powerful devices to protect your company, product names and logos. Trademarks are territorial, inexpensive to obtain and can last indefinitely given renewal every 10 years.

Further information

<http://www.wipo.int/trademarks/en/trademarks.html>

National, Community and International Trade Marks are available and careful management of appropriate TM filing strategies should be addressed.

Links to more information on Community Trademarks may be found below

General

<https://oami.europa.eu/ohimportal/en/trade-marks>

Definition

<https://oami.europa.eu/ohimportal/en/trade-mark-definition>

FAQ

<https://oami.europa.eu/ohimportal/en/faqs-community-trade-mark>

Search database

<https://oami.europa.eu/ohimportal/en/ctm-search>

Registration process

<https://oami.europa.eu/ohimportal/en/registration-process>

Search classification for designs: The Euronice classification

<http://tmclass.tmdn.org/ec2/>

Fees and payment

<https://oami.europa.eu/ohimportal/en/fees-and-payments>

Online registration

<https://oami.europa.eu/ohimportal/en/apply-now>

Internationalisation

<https://oami.europa.eu/ohimportal/en/international-cooperation>

WIPO trademarks gateway

<http://www.wipo.int/trademarks/en/>

WIPO Fee calculator

http://www.wipo.int/madrid/en/madrid_simulator/

Renewal

<https://oami.europa.eu/ohimportal/en/renewals>

Online guide

<https://oami.europa.eu/ohimportal/en/trade-marks-in-the-european-union>

1.10.7. Industrial Designs – registered and unregistered

Registered Designs

A registered design is the ornamental or aesthetic aspect of an article. The design may consist of three-dimensional features, such as the shape or surface of an article, or of two-dimensional features, such as patterns, lines or colour.

Industrial designs are applied to a wide variety of products of industry and handicraft: from technical and medical instruments to watches, jewellery, and other luxury items; from house wares and electrical appliances to vehicles and architectural structures; from textile designs to leisure goods. To be protected under most national laws, an industrial design must appeal to the eye. This means that an industrial design is primarily of an aesthetic nature, and does not protect any technical features of the article to which it is applied.

Unregistered Design Right

If you do not apply for a registered design, your creations may still receive limited protection through unregistered Design Right or copyright. However, there are some limitations to what may be protected:

- You can only stop people using your design if you can prove it was intentionally copied so Design Right is difficult to enforce.
- You can only protect the three-dimensional shape.
- Two dimensional designs may be protected by copyright but this is more difficult to enforce than a Registered Design.
- In some countries, protection lasts either 10 years after first marketing of articles that use the design, or 15 years after its creation, whichever comes first. For the last 5 years of that period the design is subject to a Licence of Right – anyone is entitled to a licence to make and sell products incorporating or copying the design.
- In EU, Unregistered Community Design Right gives an automatic protection against copying for 3 years after disclosure within the EU. NB Within the first 12 months following disclosure of your design, you may still apply for a registered Community design to increase the level of your protection.



A useful summary of comparing registered and unregistered Community Designs (vs UK Designs) may be found here
<http://www.ipo.gov.uk/types/design/d-applying/d-before/d-needreg.htm>

Useful links

Registered Community Designs (RCDs)

Registered Designs – General

<https://oami.europa.eu/ohimportal/en/designs>

Definition

<https://oami.europa.eu/ohimportal/en/design-definition>

FAQ

<https://oami.europa.eu/ohimportal/en/faqs-community-design>

Search Database

<https://oami.europa.eu/ohimportal/en/faqs-community-design>

Registration process

<https://oami.europa.eu/ohimportal/en/rcd-route-to-registration>

Search classification for designs: the Eurolocarno Classification

<https://oami.europa.eu/eurolocarno/>

Fees and payment

<https://oami.europa.eu/ohimportal/en/rcd-fees-and-payments>

Online registration

<https://oami.europa.eu/ohimportal/en/rcd-apply-now>

Internationalisation

<https://oami.europa.eu/ohimportal/en/faq-on-the-hague-agreement#12.3>

WIPO for Designs

www.wipo.int/hague/en

Industrial designs fee calculator

<http://www.wipo.int/hague/en/fees/calculator.jsp?Lang=E&ServCd=DEN&ForDate=20130528&Origin=FR&>

Renewal

<https://oami.europa.eu/ohimportal/en/renewals>

Online Guide

<https://oami.europa.eu/ohimportal/en/designs-in-the-european-union>

Unregistered Community Designs (UCDs)

Definition

<https://oami.europa.eu/ohimportal/en/designs-in-the-european-union>

Type of protection

<https://oami.europa.eu/ohimportal/en/unregistered-community-design>

1.11. How can I use my IP/IA?

For details on how you can exploit your IA/IP see

<http://www.innovaccess.eu/about-intellectual-property.php?section=Why>

IA/IP may be exploited by way of various types of agreement as set out in BCD/BBS profiles; definitions of which may be found in BCD/BBS guidelines.

1.12. Capturing IA/IP on Balance Sheets

IAS38 and IFRS3 are a set of accounting standards developed by the International Accounting Standards Board (IASB), which are becoming the global standard for the preparation of public company financial statements. Assets that should be individually accounted for under IAS38 and IFRS3 may be categorised as follows:

Technology-based – Patented technology computer software unpatented technology databases trade secrets; **Marketing-related** – Trademarks brands trade names internet domain names non-compete agreements; **Contract-based** – Licensing royalty and standstill agreements contracts for advertising construction management service or supply lease agreements construction permits franchise agreements operating and broadcasting rights use rights such as drilling water air mineral timber cutting and route authorities servicing contracts employment contracts; **Artistic-related** – **Plays, operas, ballet, books, magazines, newspapers, musical words, pictures, photographs, videos, films, television programmes;** and **Customer-related** – **Customer lists, order of production backlog, customer contracts and related relationships, non-contractual customer relationships.**

There are various tools and professional services available to help profile and value IA/IP – see **Task IV: spreadsheet "EEN IP signposting directory on IP support services"**





Annex II

1.13. Typical IP services in EEN Practice

IP in Market internationalisation

- Foreign markets strategy
- IP management advice within marketing and commercial strategies e.g. use of IP searching as a commercial tool to be aware of potential competition in foreign markets AND to avoid potential infringement of other products, processes and services in the market in foreign territories.
- IP cost / benefit analyses through assistance on IP Management, including filing strategies – such as weighing up the costs of securing registered IP rights over the perceived benefits of achieving such
- IP and anti-counterfeiting advice
 - > Raise awareness on use of confidentiality agreements etc. during first meetings and negotiation phases (including brokerage events)
 - > Raise awareness of confidentiality agreements and other appropriate legal agreements on client IP and Intellectual Assets relationship in use during negotiations with third parties e.g. distributors/ suppliers/licensees etc.

IP in Innovation and technology transfer advice

- Advice on Innovation management and valorisation of IP:
 - > Advice on appropriate IP strategies for IP protection in international exploitation, IP/IA profiling and IP/IA exploitation
 - > Advice on due diligence procedures for design and development phase
 - > IP cost / benefit analyses
- Technology transfer and IP brokering/licensing
 - > First/further company meeting – conducting appropriate IP/IA profiling as part of meeting ("IP Diagnostic") as a means to determine what intangible assets are available for exploitation and if any further management of such IP/IA is required (eg filing for registered right) before completion of EEN partner profile.
 - > Technology/Commercial/Research profile preparation and promotion.
 - > Raising awareness about confidential procedures to be adopted during first meetings and negotiation phases (brokerage events).

- > Raising awareness about confidential procedure relationship with potential licensees.
- > Technology transfer/open innovation strategy.
 - Signposting to appropriate external professional legal advice and/or other IP stakeholders, as well as provision of sample legal templates as part of awareness raising/ training on IP matters in negotiations etc.

IP Business and Financial advice

- Business plan assessment, including review of exploitation/ valorisation of IP and broader intangible assets.
- Advice on Start-up/spinoff, new entrepreneurship based on IP exploitation.
- Economic and financial Valuation of the IP and Intangible Asset for facilitating Access to finance (loans, VC, etc.).

IP in RTD funding advice

- Managing knowledge and IP sharing in consortium agreement of RTD European projects.
- Advice on due diligence procedures before research and development project.
- Advice on IP strategy and protection for international exploitation.



Annex III

1.14. Case Studies

1. Case studies to inform EEN advisers

A key message for all EEN advisers is to ensure that advice you provide on IP is accurate, factually correct and up to date [legislation changes more rapidly than you think]. There are many professional legally trained IP attorneys and lawyers who should be recommended when you reach the limit of your knowledge. This report lists most of these within each member state.

A usual problem around IP protection is that many SMEs will consider protection within their own countries only, but not protect outside because they don't expect to trade abroad. The key message here is for every business to look well into the future to predict where they hope or expect to trade, and to ensure protection is in place before trading abroad. The processes and costs for registration of patents, trade marks and designs within the EU are all listed on the iPorta, EPO and OHIM websites.

2. Case studies to inform EEN clients

The following table shows which case studies can be used to illustrate different aspects of IP.

IP Type	Company name	Country	Issues Addressed
Copyright	Kleerex Limited Vlisco Group EngCo	Ireland Netherlands UK/China	Successfully used in enforcement action to stop infringement Covers fabric s and prints Registration of copyright as evidence in foreign countries
Patents	Surface Processing Limited Kleerex Limited FAB Bere Facile S.r.l. Somatex GmbH EngCo	UK Ireland Italy Germany UK/China	Trade secrets can be patented if no prior public disclosure First in sector to use patents, protects business Searching databases is essential prior to filing a patent to identify prior art Filed internationally to protect substantial R&D investment Ensure patents are taken out prior to foreign trading
Trade marks	Surface Processing Limited FAB Bere Facile S.r.l. Somatex GmbH Vlisco Group EngCo	UK Italy Germany Netherlands UK/China	Increased brand recognition Used for marketing and in an IP protection product 'bundle' Taken out to protect company and product names Many trade marks are registered globally to protect the brand Registered before entering a foreign market
Designs	Kleerex Limited FAB Bere Facile S.r.l. Vlisco Group EngCo	Ireland Italy Netherlands UK/China	Protects business Used in an IP 'bundle' to protect an innovative product Cover the fabric designs on which the business is based Ensure designs are protected prior to foreign trade
Trade secrets	Somatex GmbH Vlisco group	Germany Netherlands	Not everything is patented, NDA's with customers Wax manufacturing technology protected at headquarters
Licensing	Surface Processing Limited Somatex GmbH	UK Germany	New global licensing revenue streams are accessible for patented IP Used for long-term business success and includes cross-licensing
Marketing	FAB Bere Facile S.r.l. Vlisco group	Italy Netherlands	Marketing a product with all forms of IP protected reduces risk Very strong marketing strategy globally underpinned with trade mark registration
Enforcement and Dispute resolution	Kleerex Limited Somatex GmbH Vlisco Group EngCo	Ireland Germany Netherlands UK/China	Not always necessary to go to court Will assess the likelihood of success beforehand Use private investigators to gather evidence of infringement Use all enforcement available in foreign countries to stop infringement, like raids on infringers premises etc